

REMARKS

No amendment has been made in response to the outstanding Non-final Office Action dated July 22, 2011. The Examiner's reconsideration is respectfully requested in view of the following remarks.

Claims 1-15 are pending for re-consideration by the Examiner upon entry of the present Response.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chang et al. (U.S. Patent No. 6,387,566; hereinafter, "Chang") in view of Shibuya et al. (U.S. Patent No. 6,509,123; hereinafter, "Shibuya").

For an obviousness rejection to be proper, the Examiner is expected to meet the burden of establishing why the differences between the prior art and that claimed would have been obvious. (MPEP 2141(III)) "A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." To find obviousness, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does." *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (Emphasis Added)

Claims 1, 8-10 and 15 are independent claims. Claims 2-7 are directly or indirectly dependent from Claim 1. Claims 11-14 are directly dependent from Claim 10.

Claims, 1, 8, 9, 10 and 15 include the following limitation:

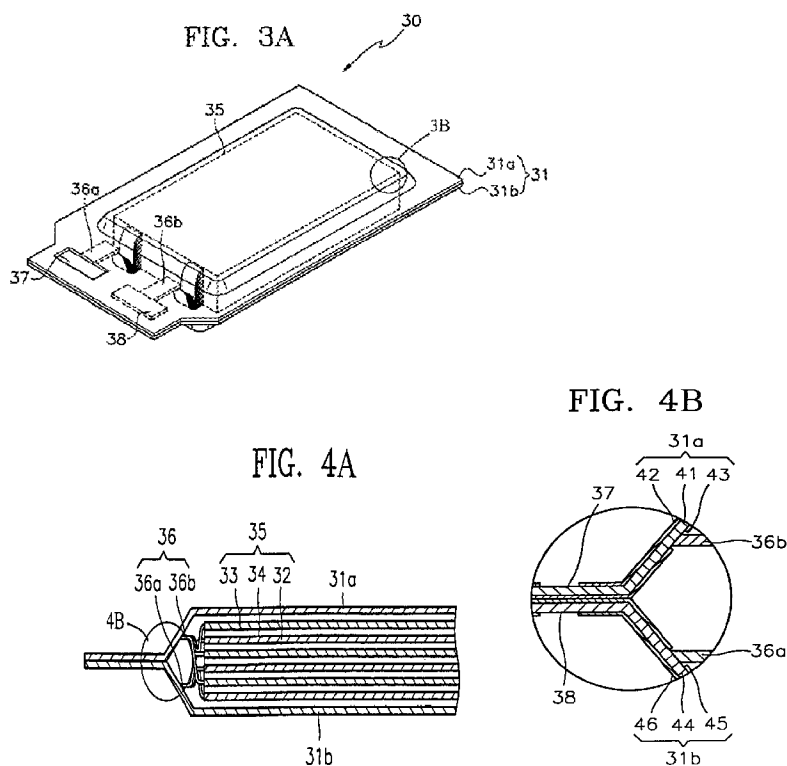
the positive terminal and the negative terminal are extended outside of the battery package in a same direction

As above, the claimed invention is configured such that the positive terminal and the negative terminal are extended outside of the battery package in a same direction, as clearly shown in Figs. 2, 9, 12 and 13 of this application.

In the outstanding Non-final Office action, the Examiner has admitted that Chang is silent as to “the positive terminal and the negative terminal are extended outside of the battery package in a same direction,” but Shibuya can be combined into Chang to reach the claimed features.

Applicants respectfully disagree with the Examiner’s characterization of the cited prior art.

Chang does not disclose any electrode terminals extended outside of the battery package (or case). As illustrated in Figs. 3A, 4A and 4B of Chang, exposed portions 37 and 38 of the aluminum layer 41 and 44 serve battery terminals. That is, in Chang, part of the outer insulating material 42 and 46 is removed to expose part of the aluminum layer 41 and 44 to thereby form the exposed portions 37 and 38, which serve battery terminals. (See lines 46-65 on column 2 of Chang)



Further, in Chang, these positive terminal 38 and the negative terminal 37 are formed on the upper case body 31a and lower case body 31b respectively, in opposite directions to each other. (See lines 57-65 on column 2 and Figs. 3A and 4B of Chang) by exposing the aluminum layer 41 and 44 intervened in each upper or lower case body. That is, the electrode terminals 37, 38 of Chang can not be extended in a same direction.

Furthermore, Chang intentionally excludes extending of the electrodes terminal outside of the battery package, as clearly shown in line 66 on column 2 through line 1 on column 3 thereof, which reads: *“Unlike the prior art, the present invention has no terminals interposed between the adhering peripheral surfaces of two case bodies. This leads to air-tight and leak-proof sealing of an electrode assembly 35 in the case 31.”*

As the Examiner has stated in the outstanding Office Action, Shibuya teaches: “The positive electrode terminal 7 preferably protrude in the same direction as the negative electrode terminal 8 but may be in any direction if no short-circuit is caused and no problem is caused in the cell performance.”

In view of the above discussions about Chang’s terminals, however, Shibuya can not be combined into Chang, without significant change or redesign in the configurations and functions of Chang, and also without losing the original purposes and operational principles intended in Chang. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Thus, it is respectfully submitted, Chang can not be changed or combined into other prior art, without losing its original purposes and associated operational principles (for example, exposing the terminals in opposite directions and not extending the terminals outside of the battery case), and thus, further submitted, the configuration of the claimed battery terminals not be a matter of choice.

Further, the Examiner is respectfully reminded of the court decisions:

To find obviousness, the Examiner must “identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does.” *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (Emphasis Added)

A hallmark of a proper obviousness rejection based on combining known prior art elements is that one of ordinary skill in the art would reasonably have expected the elements to maintain their respective properties or functions after they have been combined. *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356 (Fed. Cir. 2008). (Emphasis Added)

In view of the above discussions, Applicants respectfully submit that *prime facie* obviousness does not exist in the proposed combination of Chang and Shibuya, and thus Claims 1, 8-10 and 15 are allowable over Chang and Shibuya.

Claims 2-7 and Claims 11-14 are also believed to be allowable over the cited references, by virtue of their direct or indirect dependency from Claims 1 and 10, respectively.

Applicants respectfully request the Examiner to review these submissions and withdraw this rejection under 35 U.S.C. §103(a).

Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Reconsideration and subsequent allowance of this application are courteously requested.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

The Examiner is invited to contact Applicants' Attorneys at the below-listed telephone number with any questions or comments regarding this Response or otherwise concerning the present application.

Respectfully submitted,

CANTOR COLBURN, LLP

By: /Jaegyoo Jang/
Jaegyoo Jang
Registration No. 68540

Date: October 21, 2011
Cantor Colburn LLP
1800 Diagonal Road
Suite 510
Alexandria, VA 22314
Telephone: (703) 236-4500
Facsimile: (703) 236-4501